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10/552,244	06/06/2006	Isabelle Dubois-Brugger	38624-100578	8846

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EXAMINER

USELDING, JOHNE

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1796

NOTIFICATION DATE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

**Office Action Summary****Application No.**

10/552,244

**Applicant(s)**

DUBOIS-BRUGGER ET AL.

**Examiner**

JOHN USELDING

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-7, 9, 11, 12, 13-16, 18-20, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Widmer et al. (EP 1136507).

Regarding claims 1 and 2, 15, and 16: Widmer et al. teach three embodiments (examples E3, E4, and E5) where a concrete composition (0034, 0054) was made using polyoxyalkylene polycarbonates comprising at least 80% of structural units (1) and (2). Acrylic acid corresponds to unit (1) and monomer 2-1 corresponds to unit (2). The ratio of the number of structural units (2) to (1) + (2) is 39% for E3 (.65/1 + .65) 33% for E4 and 35% for E5. The examples teach adding these examples to a concrete composition (0054). Since Widmer et al. teach that same method and composition of claim 1 they must inherently have the same fluidity retention and slump value as the applicant has claimed otherwise the applicant has failed to claim a critical feature of their method and/or composition.

Regarding claims 4 and 18: Monomer 2-1 of Widmer et al. has  $y=0$  (Table 1). This is equivalent to the case where  $m=0$ .

Regarding claim 5: Monomer 2-1 of Widmer et al. has  $x=22$  (Table 1). This is equivalent to applicant's  $n$  value.

Regarding claims 6 and 7 and 19: Monomer 2-1 of Widmer et al. has  $R$  being a methyl group, which is an alkyl group having 1 carbon atom (Table 1).

Regarding claims 9, 11, 20, and 22: The examples of Widmer et al. teach 0% of the structural units of (1)' and (2)'. 0% is less than 25% and therefore meets the claim limitations. If (1)' and (2)' are not present in the composition then the limitations of claims 11 and 22 do not need to be met.

Regarding claims 12 and 23: The molecular weights of the polymers produced from Examples 3, 4, and 5 are all within the claimed range.

Regarding claims 13 and 24: Examples 3, 4, and 5 are all 40% dry extract solutions.

Regarding claims 14 and 25: Widmer et al. teach adding 0.2 to 1.5% of the liquid relative to the cement (0064).

Claims 1-7, 9, 11-20, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Schober et al. (EP 1136508).

Regarding claims 1-7, 9, 11, 12, 15-20, 22, and 23: Schober et al. teach in example where a concrete composition (0063) was made using polyoxyalkylene polycarbonates comprising at least 80% of structural units (1) and (2) (example polymer E3). Acrylic acid corresponds to unit (1) and methoxy polyethyleneglycol acrylate corresponds to unit (2). The ratio of the number of structural units (2) to (1) + (2) is

47%. The examples teach adding these examples to a concrete composition (0063). Since Schober et al. teach that same method and composition of claim 1 they must inherently have the same fluidity retention and slump value as the applicant has claimed otherwise the applicant has failed to claims a critical feature of their method and/or composition.

Regarding claims 14 and 25: Schober et al. teach an embodiment where polymer E3 is 0.7% of the cement composition (table 4).

Regarding claims 13 and 24: Schober et al. teach that their polymers are used as 35% solutions (0059).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widmer et al. (EP 1136507) as applied to claims 1 and 15 above.

Regarding claims 3 and 17: as shown above Widmer et al. teach an example where the ratio is 39.4% (0044). 39.4% is just 0.6% outside of the lower end of the claimed range of 40 to 60%. A prima facie case of obviousness exists where the

claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (MPEP 2144.05).

Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schober et al. (EP 1136508) as applied to claim 1 above when taken with Satoh et al. (5,911,820), Buchner et al. (6,545,067), Widmer (EP 1136507), Hirata et al. (6,388,038), Kinoshita et al. (6,140,440), and Hirata et al. (EP 0792850).

Regarding claim 8: Schober et al. also teach that their polymer is preferably made using 0-50 mol% of structural unit C (0029). Structural unit C can meet all the limitations of claim 8 with the exception that it is methacrylic instead of acrylic. It is well known in the art that acrylic can be used in the place of methacrylic and that they are interchangeable. This is evidenced by Satoh et al. (column 3, lines 15-25), Buchner et al. (column 4, lines 1-14), Widmer et al. (0024), Hirata et al. (US) (column 2, lines 16-30), Kinoshita et al. (column 2, lines 1-34), and Hirata et al. (EP) (page 3, lines 25-39). Since it is so well known in the art it would have been obvious to try structural unit C as an acrylate instead of a methacrylate in the production of the polymer. It further would have been obvious to add this compound to example polymer E3 within the ranges taught by Schober et al. since it is a part of their preferred mixture (The polymers of Schobel, it is emphasized, were devoid of units derived from propylene oxide

monomers.) In the absence of unexpected results it would have been obvious to have selected the overlapping portions of the ranges.

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schober et al. (EP 1136508) as applied to claims 1, 9 and 15 above.

Regarding claims 10 and 21: Schober et al. teaches 0% of structural units (1)' and (2)' in example E3. However in example E1 they include 17% of structural units corresponding to structural unit (2)'. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include 17% of the structural unit (2)' used in Example E1 and include it in the example E3 to make a polymer for cement compositions. The polymer would still comprise at least 75% by number of structural units (1) and (2) and would meet the property limitations of claim 1 for the same reasons as given above.

### ***Response to Arguments***

Applicant's arguments filed 10/1/2008 have been fully considered but they are not persuasive.

The applicant has made the argument that it would not have been obvious to modify the teachings of Widmer et al. to meet claims 1-3. The rejection has been modified to show that, in fact, Widmer et al. anticipate claims 1-2 and are just 0.6% away from anticipating claim 3.

The applicant has made the argument that unexpected results are obtained by using claimed dispersants requiring at least 75% total acrylate monomer and a ratio of

acrylate monomer 2 to total acrylate monomer in the range of between 20% and 80%. This aspect of the invention has been anticipated by both Widmer et al. and Schober et al. Therefore the unexpected results argument is not applicable to these rejections.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JOHN USELDING** whose telephone number is



(571)270-5463. The examiner can normally be reached on Monday-Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Uselding  
Examiner  
Art Unit 1796

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796